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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,868	07/17/2000	Thomas J. Shaw	75329 77432	8293
20873	7590	02/02/2006		
LOCKE LIDDELL & SAPP LLP ATTN: SUE COTT 2200 ROSS AVENUE SUITE 2200 DALLAS, TX 75201-6776			EXAMINER SIRMONS, KEVIN C	
			ART UNIT	PAPER NUMBER
			3767	
DATE MAILED: 02/02/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/617,868

Applicant(s)

SHAW, THOMAS J.

Examiner

Kevin C. Sirmons

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-34, 37-42, 44-50, 52 and 54-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-34, 37-42, 44-50, 52, 54-57, 81-85 and 88-95 is/are rejected.
- 7) ☒ Claim(s) 50-80, 86 and 87 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Claim Rejections - 35 USC # 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 37-42, 44-50, 52, 54-57, Q1-85, 88-95, 29-34 are rejected under 35 U.S.C. 102(a) as being anticipated by Shaw U.S. Pat. No. 5,385,551.

Shaw discloses a syringe comprising: a hollow body comprising a barrel having a front end portion (12) in which a retraction mechanism (22) is mounted, the retraction mechanism having a needle (34) and a continuous retaining member (102) which holds the retractable needle, and a back end portion having an opening (102)\*, a plunger (24) having a front end portion comprising a head (42) and a supporting surface located on the front end portion (portions adjacent the head), with a plunger seal element (44) fixed on the supporting surface, and a back end portion with an end cap (56), the retraction mechanism being operable by forward movement of the plunger without distorting the barrel (figs. 1-5), the plunger being reciprocally mounted in said barrel with the plunger seal element in sliding contact with the barrel (figs. 1-5), whereby forward movement of the plunger releases the needle from the continuous retaining member by applying a separating force to the continuous retaining member, without the aid of the plunger seal element and without relative movement between the plunger seal element and its supporting surface (the device of Shaw is fully capable of performing the function set

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forth in the claim); the plunger end cap being receivable into the opening in the back end portion of the hollow syringe body upon retraction (see proximal portion of syringe body); as to claims 38-40, (figs. 1-5); as to claim 41, (50); as to claim 42, (figs. 1-5); as to claim 44, (figs. 1-5); as to claims 45-50, 52, (see above rejection); as to claim 54, (see above rejection and a rigid plunger seal element stop surface which acts as a plunger seal element stop (see protrusion on the distal portion of 38)); as to claim 55, (see above rejections); as to claims 56-57, (see above rejections); as to claims 81-85, 88-95, (see above rejections); as to claim 29, (see above rejection); as to claim 30, (see distal portion of the barrel); as to claims 31-34, 37, (see above rejections).

#### ***Allowable Subject Matter***

Claims 58-80, 86 and 87 are allowable over the prior art of record.

#### ***Conclusion***

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 9/16/04 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin C. Sirmons whose telephone number is 571-272-4965. The examiner can normally be reached on Monday-Friday 6:30-4:00 ALT FRI.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin C. Sirmons  
Primary Examiner  
Art Unit 3767

2/1/06

A handwritten signature in black ink, appearing to read "Kevin C. Sirmons", is written over the printed name and date.